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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,446	04/20/2004	Kazumi Minoguchi	0051-0226PUS1	2718
2292 7590 02/22/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
SEVERSON, RYAN J				
ART UNIT		PAPER NUMBER		
3731				
NOTIFICATION DATE		DELIVERY MODE		
02/22/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/827,446

Applicant(s)

MINOGUCHI ET AL.

Examiner

Ryan J. Severson

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-10 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 6, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakata et al. (Des. 368,965) in view of Sasaki (JP 06-339514).**
- Nakata et al. disclose the apparatus substantially as claimed, including first and second tooth-hardening members each having projections being capable of being chewed by an infant and a gripping opening. However, Nakata et al. do not disclose the first and second tooth-hardening members have different hardnesses.
3. Attention is drawn to Sasaki, who teaches the center portion of a child's toy be hard resin and the outer members be soft (see the abstract and constitution sections of the abstract translation) to allow the device to be used as a tooth hardener for infants. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the toy of Nakata et al. of hard material at its center (the first surface of the first tooth-hardening member) and softer at the peripheral projections (the second tooth-hardening member) to allow the toy to be used as a tooth hardening device.

4. **Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakata et al. (Des. 368,965) in view of Sasaki (JP 06-339514) as applied to claim 6 above, and further in view of Monaco (2,532,116).** The combination of Nakata et al. and Sasaki does not specifically disclose colored balls inside an opening with a transparent cover. Attention is drawn to Monaco, who teaches the use of colored balls (18) inside an opening with a transparent cover on a teething device to enhance the entertainment value of the device to the child. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an opening with colored balls in the device of the combination of Nakata et al. and Sasaki, as taught by Monaco, to enhance the entertainment value of the device to the child.

5. **Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakata et al. (Des. 368,965) in view of Sasaki (JP 06-339514) and Monaco (2,532,116) as applied to claim 7 above, and further in view of Ripley (1,117,093).** The combination of Nakata et al., Sasaki, and Monaco does not disclose holes in the transparent cover. Attention is drawn to Ripley, who teaches holes or openings can be formed in a member that contains balls to increase the noise created by the balls tumbling in the open space to enhance the entertainment value of the device to the child. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the openings of Ripley with the cover of the combination of Nakata et al., Sasaki, and Monaco to enhance the entertainment value of the device to the child by creating more noise.

Response to Arguments

6. Applicant's arguments filed 10/26/2009 have been fully considered but they are not persuasive.
7. Applicant first argues the Nakata et al. device is not disclosed as being a tooth hardening device as claimed. However, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is the Examiner's position that the device of the *combination* set forth above meets all of the structural limitations of the claims, and therefore is capable of performing the claimed intended use (i.e. for tooth hardening).
8. Examiner notes that the devices of Nakata et al. and Sasaki do *not* differ substantially, as asserted by the applicant. Both devices have a first (central) member and a second (peripheral) member arranged around the circumference of the first member. The dome shape structure of Sasaki is analogous to the ring structure of Nakata et al., which is capable of being chewed by an infant. The petals of Sasaki are analogous to the peripheral structures of Nakata et al. Therefore, the proposed combination is to make the central portion of Nakata et al. harder than the peripheral portions, which is taught in Sasaki. The proposed combination does not rely on the exact structure of Sasaki in any way, but rather the fact that the peripheral structures are softer than the central structure. Therefore, applicants argument that the office action does not explain how an infant could possibly get its teeth around the domed

portion of Sasaki is not persuasive because it is in no way relevant to the rejection. This is merely a piecemeal analysis of Sasaki on the part of the applicant, where the rejection was based on a combination of Nakata et al. and Sasaki. Examiner notes further that applicant explicitly admits that the inner annulus (central portion or first member) of Nakata et al. is capable of being grasped and chewed by an infant (see pages 12 and 13 of 18 of the response). At no point did Examiner suggest modifying the inner annulus of Nakata et al. to be the dome shaped structure shown in Sasaki. The structural shape of Nakata et al. is not being modified in any way by the teachings of Sasaki.

9. Applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

10. Further still, although not relied upon for the rejection above, applicant is reminded it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Therefore, making the device of Nakata et al. of the claimed materials (having the claimed relative hardnesses) is within the level of one having ordinary skill in the art.

11. Examiner notes applicants argument that the "adapted to" language in the claims must be considered a positively recited structural feature, and cites *In re Venezia*. However, the facts of that case do not apply to the situation in the present application.

The *In re Venezia* situation dealt with two structural elements capable of being or adapted to be assembled or positioned relative to one another. However, in the instant application, the applicant is reciting an *intended use* for how the device is to be used by a human, not how two or more structures are adapted or intended to be positioned relative to one another. The claim at best requires the device to be able to be chewed by an infant, which applicant has already admitted the Nakata et al. device is capable of doing.

12. Finally, Examiner notes that it appears the applicant forgot to correct the copy-and-paste conclusion from the previous response. For example, the previous office action was not a final rejection, and therefore finality of that action cannot be withdrawn. Also, claim 17 is not considered for the reasons set forth in the advisory action of 3/20/2009.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan J. Severson whose telephone number is (571) 272-3142. The examiner can normally be reached on Monday - Friday 8:30-5:00.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan J. Severson/
Examiner, Art Unit 3731
2/15/10

/Anh Tuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
2/16/10